

REMARKS

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 15-23, 27-45 and 47-60 are pending. In this Amendment, claims 1-14 and 46 are withdrawn, claims 24-26 are canceled, claims 16, 19, 23, 40 and 43 are amended and claims 47-60 are added. No new matter is added.

The Examiner is thanked for indicating that claims 15-22 are allowable.

Applicant thanks the Examiner for the courtesies extended to Applicant's representative during a February 19, 2004, telephone interview in which the outstanding rejection was discussed. Applicant's separate record of the substance of the interview is contained in the comments below.

Claims 23-45 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,301,506 to den Boer. This rejection is respectfully traversed with respect to the claims as currently presented.

The rejection of claims 23-45 under 35 U.S.C. § 102(b) as being anticipated by den Boer is improper, because the rejection under 35 U.S.C. § 102(b) set forth in the Office Action on its face did not and could not meet the requirements of § 102(b). The requirement of 35 U.S.C. § 102(b) is, as stated in the Manual of Patent Examining Procedure (MPEP), "**TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM.**" (MPEP § 2131 (8th ed. 2001) (emphasis in original); *see In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102(b), every element of the claimed invention must be identically shown in a single reference.") (quoting *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 U.S.P.Q.2d (BNA) 1315, 1317 (Fed. Cir. 1988)); *Verdegaal Brothers Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d (BNA) 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."); *W.L. Gore and Associates v. Garlock, Inc.*, 721 F.2d 1540,

220 U.S.P.Q. (BNA) 303, 313 (Fed. Cir. 1983) (“Anticipation requires that the disclosure in a single prior art reference of each element of the claim under consideration.”)). In addition, the single prior reference must disclose each element of the claimed invention “as arranged in the claim.” (*Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 U.S.P.Q. (BNA) 481, 485 (Fed. Cir. 1984); *see MPEP § 2131*).

It is clear that none of the elements of claims 23-45 were addressed in the rejection. The Examiner simply made the conclusory statement that “Claims 23-45 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by den Boer et al. (U.S. pat. 6,301,506)”. Conclusory statements are insufficient to establish a *prima facie* rejection. (*See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002) (stating the Board’s general conclusions in making its decision is insufficient)).

For the above reasons, the rejection of claims 23-45 under 35 U.S.C. § 102(b) based on den Boer *et al.* is *prima facie* improper and should therefore be withdrawn.

In addition, den Boer is technologically insufficient to teach or suggest all the elements of claims 23-45.

In particular, claim 23 recites a primary source configuration and a secondary source configuration for generating EM fields. Claims 40 and 45 recite two source configurations for field generation. On the other hand, den Boer, only teaches or suggests the use of a single source configuration - the coil that works in conjunction with the frequency generator to transmit electromagnetic waves (see Col. 3, lines 45-48). Den Boer is primarily focused on the determination of a supposedly optimum treatment frequency by sensing skin temperature changes resulting from a series of frequencies generated from a single source. The presently claimed invention instead focuses on an apparatus for treatment using two source configurations.

In addition, with respect to claims 40 and 45, den Boer fails to teach or suggest a minimum exposure time of 20 minutes. In fact, den Boer indicates that the sum total of an individual treatment should be on the order of 15-60 seconds (see Col. 2, lines 53-57).

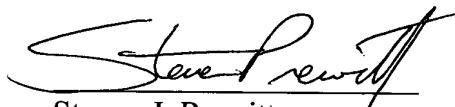
Such a short treatment duration is insufficient to provide the effects described in the present invention. Thus, the combination of treatment duration and the use of two source configurations in claims 40 and 45 distinguish the present invention from the teachings of den Boer.

Claims 27-39 and 41-44 depend directly or indirectly from claims 23 and 40, and, accordingly, include all of the patentable features of claims 23 or 40 as well as other patentable features. Therefore, claims 27-39 and 41-44 are patentable over den Boer for at least the reasons discussed above with respect to claims 23 and 40.

Furthermore, new claims 47-60 mirror claims 23 and 27-39, except that the secondary source configuration in claim 47 is not spatially uniform, but rather is spatially varying. Thus, new claims 47-60 are patentable for at least the reasons discussed above with respect to claim 23.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Steven J. Prewitt at 703-591-2664, Ext. 2003. In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,



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